

## **REMARKS**

### **I. Introduction**

Claims 1, 2, 6-18, 20-24, 26-37, 40-43, 45-48, and 50-63 are pending in this application.

Claims 1, 2, 6-18, 20-34, 36, 37, 40-43, 45-48, and 50-53 were rejected under 35 U.S.C. § 102(e) as being anticipated by Srinivasan et al. U.S. Patent No. 6,357,042 ("Srinivasan"). Claims 1 and 37 were also rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 35 was rejected under 35 U.S.C. § 103(a) as being obvious over Srinivasan. Claim 35 was also rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written requirement.

Claim 35 has been amended to add more clarity to the claimed invention. The amendment is fully supported by the application as originally filed and does not add new matter. The Examiner's rejections are respectfully traversed.

### **II. Summary of Telephonic Interview**

On April 11, 2007, applicants' representative, Michael Chasan (Registration No. 54,026), conducted a telephonic interview with the Examiner. Applicants and applicants' representatives would like to thank the Examiner for the courtesies extended during the interview. During the interview, the Examiner and Mr. Chasan discussed the 35 U.S.C. § 112 rejection of claims 1 and 37. Mr. Chasan, pointing to applicants' specification, explained that claims 1 and 37 satisfy the requirements of the second paragraphs of § 112. The Examiner agreed to review detailed arguments in support of applicants' position to determine how to proceed.

Detailed arguments in support of applicants' position are presented below.

### **III. The § 112 Rejections**

#### **A. Claim 35**

The Examiner rejected claim 35 for allegedly failing to comply with the written description requirement. Although applicants disagree with the Examiner, claim 35 has been amended to recite that "the at least one source address is a telephone number." Support for this amendment can be found in, for example, original claim 35.

Applicants believe that this amendment obviates the rejection of claim 35 under § 112 and therefore respectfully requests reconsideration and withdrawal of the § 112 rejection of claim 35.

B. Claims 1 and 37

Each of claims 1 and 37 stands rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to point out and particularly claim the subject matter which applicants regard as the claimed invention. In support of this rejection, the Examiner states:

Claims 1 and 37 recite "receiving at the user equipment the plurality of advertisements related to at least one object." Said limitation is indefinite because it seems to recite that a plurality of advertisements are linked to a single object when Applicant[s]' specification teaches that an object is linked to a[] URL source and said URL source is used to pull or push advertisements located in said source. (Office Action, page 3, lines 1-6).

Applicants respectfully disagree with the Examiner. As a preliminary matter, the rejection under § 112, second paragraph is improper because the Examiner's stated reasons for deeming the claims "indefinite" do not relate to any requirement under § 112, second paragraph. According to the MPEP, "[t]he requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles....Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." (MPEP § 2173.02). In this case, the Examiner has not advanced any argument that pertains to clarity or precision (or lack thereof) of claims 1 and 37. Rather, the Examiner appears to contend that the specification does not provide adequate support for the subject matter set forth in the claims, which is a separate and distinct issue from the requirements of § 112, second paragraph. For at least this reason, applicants request reconsideration and withdrawal of the § 112, second paragraph rejection of claims 1 and 37.

Furthermore, contrary to the Examiner's contention, the specification provides adequate support for the subject matter set forth in claims 1 and 37. In particular, applicant's specification reasonably conveys to one of ordinary skill in the art that an advertisement may be

selected from a plurality of advertisements related to one object. For example, the specification states\*:

The selecting of an advertisement may be based on metadata attached to and/or associated with media and/or a selectable object imbedded within the media. For example, when media and/or a selectable object within the media is selected, the metadata attached to and/or associated with the media and/or selectable object may be read. Then, an advertisement corresponding to the metadata read may be selected. The advertisement may be selected by comparing the metadata of the media or selected object with metadata from advertisements. (Page 12, lines 20-30, emphasis added).

The cited passage reasonably conveys to one skilled in the art that, for example, one object may be related to a plurality of advertisements. In particular, the passage clearly states that an advertisement for a selected object may be selected by comparing metadata associated with the selected object with metadata associated with advertisements. Although applicants' specification also describes embodiments which may include a URL to download an advertisement (see, e.g., paragraph 39), it is apparent from the specification that these are simply illustrative embodiments, and that a URL does not constitute a critical feature of the invention as a whole. It is therefore improper, as a matter of law, for the Examiner to import the limitations of these embodiments from the specification into the claims (see MPEP 2111.01 (II)) and the rejection under § 112 should be withdrawn for this additional reason.

#### IV. The § 102(e) Rejection

Each of claims 1, 2, 6-18, 20-34, 36, 37, 40-43, 45-48, and 50-63 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Srinivasan. This rejection is respectfully traversed.

According to the MPEP, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP 2131). Srinivasan fails to teach each and every limitation of at least the independent claims.

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\* It is understood that the cited passages are merely illustrative and should not to be construed as limitations on the claimed subject matter. It is also understood that support for the claims may be found in other parts of the specification.

A. Independent Claims 1 and 37 Patently Distinguish Over Srinivasan

Independent claims 1 and 37 are directed to a method and a system for providing metadata-selected advertisements. As recited in the claims, advertisements relating to at least one object in media are received at user equipment. A user selection of one of the at least one object is received, and one of the advertisements received at the user equipment is selected by comparing at the user equipment metadata associated with the selected object and metadata associated with the advertisements received at the user equipment. Srinivasan fails to describe this subject matter.

In particular, Srinivasan fails to describe receiving a plurality of advertisements at user equipment and selecting one of the advertisements by comparing at the user equipment metadata associated with a selected object and metadata associated with the advertisements received at the user equipment. The Action asserts that this subject matter is described in column 7, lines 25-50, column 12, lines 20-35, and column 22, lines 1-10 of Srinivasan (see Office Action page 5, lines 5-8). Applicants have carefully reviewed the cited sections and find, based on this review, that Srinivasan does not describe this subject matter. In particular, the cited sections make reference to presenting information to end users based on user interactions with an on-screen entity (see column 7, lines 45-50), invoking "a link to a network-based data server that may deliver" video media including interactive advertisements to an end user (see column 12, lines 20-34), and "downloading" of additional information regarding a user's interactions with a video stream (column 22, lines 1-10). The cited sections, however, do not describe comparing metadata of an object with metadata of advertisements at the user equipment to select one of a plurality of advertisements received at user the equipment, as explicitly recited in claims 1 and 37.

In response to applicants' rebuttal arguments filed September 21, 2006, the Examiner maintains that Srinivasan teaches this subject matter because, according to the Examiner, "Srinivasan teaches that the additional network-stored information about an entity is used to select advertisements when a user selects the entity, where the inserted metadata in said entity (i.e. URL; see col 17, lines 20-25) is used to pull advertisements related to said selected entity." (Office Action, page 12, lines 13-17). However, even if Srinivasan teaches that "the additional network-stored information about an entity is used to select advertisements when a user selects the entity," as contended by the Examiner, this purported teaching does not constitute a sufficient basis for anticipation of the subject matter set forth in claims 1 and 37. In particular, claims 1 and 37 are explicitly directed to selecting an advertisement from a plurality

of advertisements received locally at the user equipment by comparing locally at the user equipment metadata associated with a selected object and metadata associated the plurality of advertisements. A general reference to using "additional network-stored information about an entity" to select advertisements "when a user selects the entity" does not expressly or inherently anticipate each and every element as set forth in claims 1 and 37, as is required for a rejection under § 102. Thus, Srinivasan does not teach each and every limitation of claims 1 and 37, as is required for a rejection under § 102.

For at least the foregoing reasons, applicants respectfully request reconsideration and withdrawal of the § 102 rejection of independent claims 1 and 37. Claims 2, 6-10, 12-17, 40-42, and 54-63 depend from claims 1 and 37 and add further limitations thereto. Applicants therefore respectfully request reconsideration and withdrawal of the § 102 rejection of these claims for at least the same reasons.

B. Independent Claims 18, 32, 36, 43, 48, and 53  
Patently Distinguish Over Srinivasan

Independent claims 18, 32, 36, 43, 48, and 53 are directed to methods and systems for providing metadata-selected advertisements. As recited in the claims, a plurality of advertisements related to media are received at user equipment and one of the advertisements is selected by comparing, at the user equipment, metadata associated with the media with metadata associated with the plurality of advertisements. As set forth above in Section IV-A, Srinivasan does not describe this subject matter.

Applicants therefore request reconsideration and withdrawal of the § 102 rejection of claims 18, 32, 36, 43, 48, and 53. Claims 20-24, 26-31, 33-34, 45-47, and 50-52 depend from claims 18, 32, 36, 43, and 48 and add further limitations thereto. Applicants therefore requests reconsideration and withdrawal of the § 102 rejection of these claims for at least the same reasons.

V. The § 103 Rejection of Claim 35

Claim 35, which depends from independent claim 32, stands rejected under § 103(a) as being unpatentable over Srinivasan. The rejection of claim 35 relies, at least in part, on the same erroneous basis as the § 102 rejection of claim 32. As set forth above, Srinivasan fails to teach each and every element of claim 32. Applicants therefore respectfully request reconsideration and withdrawal of the § 103 rejection of claim 35 on the same grounds.

VI. Comments on the Examiner's Response to Arguments

Applicants wish to correct the record with regard to certain inaccurate statements made in the Action. In particular, in response to applicants' rebuttal arguments filed on September 21, 2006, the Examiner states:

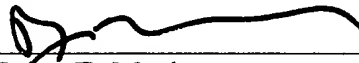
Applicant's specification teaches that an object is linked to an URL source and said URL source is used to pull or push advertisements located in said source (see Applicant's specification page 12). Therefore, contrary to Applicant's argument, Applicant's specification teaches a need to associate each advertisement with a URL. That the advertisement at the URL source address is updated for a new advertisement does not mean that said new advertisement is not linked to said URL source address. (Office Action, page 11, lines 5-11)

As set forth in Section III-B above, although applicants' specification describes embodiments which may include a URL to download an advertisement (see, e.g., paragraph 39), it is apparent from the specification that these are simply illustrative embodiments, and that a URL does not constitute a critical feature of the invention as whole. In particular, applicants do not state or imply anywhere in the specification "a need to associate each advertisement with a URL," as contended by the Examiner.

VII. Conclusion

For at least the foregoing reasons, applicants respectfully submit that this application is in condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,



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